

Notice of Allowability

Application No.

09/981,636

Examiner

Zachariah Lucas

Applicant(s)

MARKS ET AL.

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1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Response of September 27, 2005.
2. ☒ The allowed claim(s) is/are 1-15 and 73-93.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

1. Currently, claims 1-15 and 73-93 are pending in the application. In the prior action, mailed on November 5, 2004, claims 1-15, and 73-93 were pending, with claims 4 and 73-76, 80, 82, 90, and 91 withdrawn as to nonelected inventions; and claims 1-3 and 5-15, 77-79, 81, 83-89, 92, and 93 rejected. In the Response filed on September 27, 2005, claims 1, 75, 92, and 93 were amended.

2. Claim 1 is generic and allowable. Accordingly, the restriction requirement as to the encompassed inventions is hereby withdrawn and claims 4, 73-76, 80, 82, 90, and 91, directed to inventions no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Claims 1-15, and 73-93 are allowed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **(Prior Rejection- Withdrawn)** Claim 92 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it was unclear what is meant by the phrase “a member cell.” In view of the amendment of the claim, the rejection is withdrawn.

6. **(Prior Rejection- Withdrawn)** Claim 93 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite because it was not clear what is meant by reference to “said cell.” In view of the amendment of the claim, the rejection is withdrawn.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **(Prior Rejection- Withdrawn)** Claims 1, 3, 10, 13-15, 77, 78, 81, 83-85, 87-89, 92, and 93 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hein et al. (U.S. Patent 6,251,392- of record in the December 2002 IDS) in view of the teachings of Hurwitz et al. (PNAS 92:3353-57- of record in the July 2003 IDS) and U.S. Patent 5,296,348 (the '348 patent, issued to Rakowicz-Szulczynska). In view of the amendments to claim 1, and the arguments presented in the Response, the rejection is withdrawn.

9. **(Prior Rejection- Withdrawn)** Claims 2 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hein, Hurwitz, and the '348 patent as applied above, and further in view of Burmer et al. (U.S. Patent 6,087,103) and of Collins (U.S. Patent 5,770,422) and Freed et al. (U.S. Patent 5,597,719). This rejection is withdrawn for substantially the same reasons as indicated with respect to the rejection of claims 1, 3, 10, 13-15, 77, 78, 81, 83-85, 87-89, 92, and 93 above.

10. **(Prior Rejection- Withdrawn)** Claims 6 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hein, Hurwitz, and the '348 patent as applied above, and further in view of Barbas et al., PNAS 88:7978-7982) and Ward et al. (J Immunol Methods 189: 73-82). This

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rejection is withdrawn for substantially the same reasons as indicated with respect to the rejection of claims 1, 3, 10, 13-15, 77, 78, 81, 83-85, 87-89, 92, and 93 above.

11. **(Prior Rejection- Withdrawn)** Claims 9-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hein, Hurwitz, and the '348 patent as applied above, further in view of the teachings of Plant et al. (U.S. Patent 5,389,523- of record in the July 2003 IDS) and Szoka et al. (U.S. Patent 6,593,308). This rejection is withdrawn for substantially the same reasons as indicated with respect to the rejection of claims 1, 3, 10, 13-15, 77, 78, 81, 83-85, 87-89, 92, and 93 above.

12. **(Prior Rejection- Withdrawn)** Claims 9 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hein, Hurwitz, and the '348 patent as applied above, further in view of Stewart et al. (U.S. Patent 6,087,452). This rejection is withdrawn for substantially the same reasons as indicated with respect to the rejection of claims 1, 3, 10, 13-15, 77, 78, 81, 83-85, 87-89, 92, and 93 above.

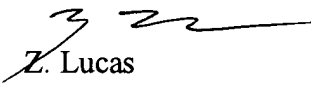
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

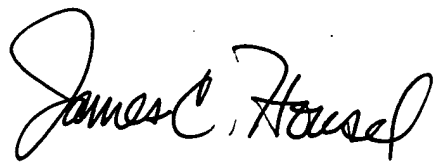
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Z. Lucas
Patent Examiner



JAMES HOUSEL 11/14/05
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600